

**REMARKS**

Claims 1-12 and 29 remain in this application. New Claim 29 is presently added. No claims are presently amended. Claims 13-20 and 22-28 are presently canceled without prejudice or disclaimer. Reconsideration of this application in light of the following remarks is requested.

**Rejections Under 35 U.S.C. §103**

**Claims 1, 3-5 and 11**

Claim 1 recites:

1. (Previously Presented) A surgical instrument comprising:
  - (a) a handpiece having a tool supporting end, and a battery receiving end;
  - (b) a sterile package comprising a single use, disposable battery pack having an attachment end;
  - (c) one of the battery receiving end and attachment end having an alignment post with a plurality of electrical contacts arranged concentric thereto, and the other thereof having a central opening defining a longitudinal axis with a set of electrical contact elements concentric to that axis; and
  - (d) wherein the two sets of contacts are adapted to become lockingly and conductively interengaged upon engagement of the alignment post with the central opening *and in response to rotation of the battery pack relative to the handpiece.*

Claim 3 recites:

3. (Original) A surgical instrument for performing a cutting, shaping, or drilling operation on bone or hard tissue, comprising:
  - (a) a handpiece having a tool supporting end, and a battery receiving end with a set of electrical contact elements thereon;
  - (b) a sterile package containing a disposable battery, the battery chemistry being based upon lithium/manganese dioxide;
  - (c) the disposable battery having an attachment end with a set of electrical contact elements on its attachment end;

(d) the handpiece and the battery each having a defined longitudinal axis, each set of electrical contact elements being arranged generally concentric to that axis, and wherein *in response to rotation of the battery pack relative to the handpiece the sets of contacts are adapted to become lockingly and conductively interengaged* prior to the surgical procedure.

Claim 4 recites:

4. (Previously Presented) A surgical instrument comprising:
- (a) a handpiece having a tool supporting end, and a battery receiving end with an alignment post extending therefrom, the battery receiving end of the handpiece also having a set of electrical contact elements arranged in generally concentric relation to the alignment post;
  - (b) a single use, disposable battery pack having an attachment end with a central opening therein, and a set of mating electrical contact elements arranged in a generally circular configuration concentric to the central opening;
  - (c) the sets of mating contacts being adapted to come into a mutually concentric relation in response to insertion of the alignment post into the central opening;
  - (d) the sets of contacts *upon rotation of the battery pack relative to the handpiece being adapted to then become lockingly and conductively interengaged* in a predetermined relative position; and
  - (e) means indicating by at least one of sight, sound, and touch that the predetermined relative position has been achieved.

Claim 5 recites:

5. (Previously Presented) A surgical instrument for performing a cutting, shaping, or drilling operation on bone or hard tissue, comprising:
- (a) a handpiece having a battery receiving end with an alignment post extending therefrom;
  - (b) a sterile package containing a single use, disposable battery pack which has an attachment end with a central opening therein;
  - (c) the central opening in the single use, disposable battery pack being adapted to insertably receive the alignment post so as to establish a mutual alignment axis of handpiece and battery pack;
  - (d) the battery receiving end of the handpiece and the attachment end of the single use, disposable battery pack having flat end surfaces adapted for abutting engagement while yet allowing relative rotation of the battery pack relative to the handpiece;

(e) the battery receiving end of the handpiece and the attachment end of the single use, disposable battery pack having mating sets of electrical contact elements, each set being arranged generally concentric to the mutual alignment axis; and

(f) wherein upon the insertion of the alignment post of the handpiece into the opening of the battery pack, *the sets of mating contacts are adapted to then become lockingly and conductively interengaged in response to rotation of the battery pack relative to the handpiece.*

Claim 11 recites:

11. (Original) A surgical instrument for performing a surgical procedure on bone or hard tissue, comprising:

(a) a handpiece having a tool supporting end, and a battery receiving end with an alignment post extending therefrom, the battery receiving end of the handpiece also having a set of electrical contact elements arranged in generally concentric relation to the alignment post;

(b) a disposable battery having an attachment end with a central opening therein, and a set of mating electrical contact elements arranged in a generally circular configuration concentric to the central opening therein;

(c) the central opening in the disposable battery being adapted to receive the alignment post of the handpiece in a partially inserted position so as to establish a pre-attachment alignment thereof;

(d) the sets of mating contacts being adapted to come into a mutually concentric relation in response to a further insertion of the alignment post into the central opening; and

(e) *the sets of contacts being adapted to then become lockingly and conductively interengaged upon rotation of the battery pack relative to the handpiece.*

Claims 1, 3 and 5 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,368,954 to Bruns ("Bruns") in view of U.S. Patent No. 4,823,244 to Alaybayoglu ("Alaybayoglu"). Claims 4 and 11 were rejected under 35 U.S.C. § 103 as being unpatentable over Bruns alone. Applicant traverses these rejections on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claims 1, 3-5 and 11.

As the PTO recognizes in MPEP § 2142:

*... The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the Examiner has not factually supported a *prima facie* case of obviousness for the following, mutually exclusive, reasons.

**1. Even When Combined, the References Do Not Teach the Claimed Subject Matter**

The Bruns and Alaybayoglu patents cannot be applied to reject claims 1, 3-5 or 11 under 35 U.S.C. § 103 which provides that:

*A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ... (Emphasis added)*

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, since neither Bruns and Alaybayoglu teaches "... wherein the two sets of contacts are adapted to become lockingly and conductively interengaged upon engagement of the alignment post with the central opening and in response to rotation of the battery pack relative to the handpiece ...," as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Similarly, since neither Bruns and Alaybayoglu teaches "... the handpiece and the battery each having a defined longitudinal axis, each set of electrical contact elements being arranged generally concentric to that axis, and wherein in response to rotation of the battery pack relative to the handpiece the sets of contacts are adapted to become lockingly and conductively interengaged prior to the surgical procedure ...," as is claimed in claim 3, it is impossible to

render the subject matter of claim 3 as a whole obvious, and the explicit terms of the statute cannot be met.

Similarly, since neither Bruns and Alaybayoglu teaches "... the sets of contacts upon rotation of the battery pack relative to the handpiece being adapted to then become lockingly and conductively interengaged in a predetermined relative position ...," as is claimed in claim 4, it is impossible to render the subject matter of claim 4 as a whole obvious, and the explicit terms of the statute cannot be met.

Similarly, since neither Bruns and Alaybayoglu teaches "... wherein upon the insertion of the alignment post of the handpiece into the opening of the battery pack, the sets of mating contacts are adapted to then become lockingly and conductively interengaged in response to rotation of the battery pack relative to the handpiece ...," as is claimed in claim 5, it is impossible to render the subject matter of claim 5 as a whole obvious, and the explicit terms of the statute cannot be met.

Similarly, since neither Bruns and Alaybayoglu teaches "... the sets of contacts being adapted to then become lockingly and conductively interengaged upon rotation of the battery pack relative to the handpiece ...," as is claims in claim 11, it is impossible to render the subject matter of claim 11 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

## **2. Nonanalogous art cannot be used to establish obviousness**

The Bruns patent relates to power hand tools while the Alaybayoglu patent is related to light sources for medical applications. 35 USC §103 requires that obviousness be determined on the basis of whether at the time the invention was made a person of ordinary skill in the art to

which the subject matter pertains would have found the claimed invention as a whole obvious. Although one of ordinary skill in the art is presumed to be aware of all prior art in the field to which the invention pertains, he is not presumed to be aware of prior art outside that field and the field of the problem to be solved, *i.e.*, nonanalogous art. Accordingly, in assessing the propriety of any assertion of prior art as a basis for a *prima facie* case of obviousness one must determine the scope or bounds of the knowledge of one of ordinary skill in the art, *i.e.*, the analogous art presumably known by one of ordinary skill in the art.

Here, since power hand tools are clearly outside the field of light sources for medical equipment, the cited references are from nonanalogous art, thus precluding any *prima facie* case of obviousness.

Thus, for this independent reason alone, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

### **3. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness**

In the present case the Bruns reference, by providing for a "simple snap-in of the locking means on axial insertion of the battery casing into the locating arrangement, and a simple release of the locking means by twisting the battery casing against the locating arrangement" (column 2, lines 1-5), is directed to a system in which coupling the battery pack to the hand tool requires an axial motion and removing the battery pack from the tool requires rotating the battery pack relative to the hand tool. Thus, this system clearly teaches away from claims 1, 3-5 and 11, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the Examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

#### **4. The Combination of References is Improper**

Assuming, *arguendo*, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the Bruns and Alaybayoglu patents cannot be applied to reject claims 1, 3-5 and 11 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

*...the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The Examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither Bruns and Alaybayoglu teaches, or even suggests, the desirability of the combination since neither teaches:

- "... the two sets of contacts are adapted to become lockingly and conductively interengaged upon engagement of the alignment post with the central opening and in response to rotation of the battery pack relative to the handpiece ...," as specified above and as claimed in claim 1;
- "... the handpiece and the battery each having a defined longitudinal axis, each set of electrical contact elements being arranged generally concentric to that axis, and wherein in response to rotation of the battery pack relative to the handpiece the sets of contacts are adapted to become lockingly and conductively interengaged prior to the surgical procedure ...," as specified above and as claimed in claim 3;

- "... the sets of contacts upon rotation of the battery pack relative to the handpiece being adapted to then become lockingly and conductively interengaged in a predetermined relative position ...," as specified above and as claimed in claim 4;
- "... wherein upon the insertion of the alignment post of the handpiece into the opening of the battery pack, the sets of mating contacts are adapted to then become lockingly and conductively interengaged in response to rotation of the battery pack relative to the handpiece ...," as specified above and as claimed in claim 5; or
- "... the sets of contacts being adapted to then become lockingly and conductively interengaged upon rotation of the battery pack relative to the handpiece ...," as specified above and as claimed in claim 11.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claims 1, 3-5 and 11. Therefore, for this mutually

exclusive reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

New Claim 29 is also not obvious in view of the references relied upon by the Examiner.

**Conclusion**

It is clear from all of the foregoing that independent claims 1, 3-5, 11 and 29 are in condition for allowance. Dependent claims 2, 6-10 and 12 depend from and further limit independent claims 1, 3, 5 and 11 and, therefore, are allowable as well.

An early formal notice of allowance of claims 1-12 and 29 is requested.

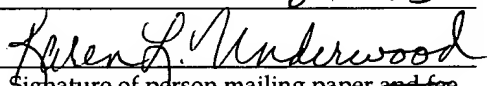
Respectfully submitted,



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